

Assistant Commissioner
for Patents
Washington, D.C. 20213

**TRAVERSAL AND REQUEST FOR
RECONSIDERATION OF REQUIREMENT FOR RESTRICTION**

Dear Sir:

Applicants, through their undersigned attorneys, hereby traverse the requirement for restriction set forth in an Official Action dated October 11, 2001, in the above-identified patent application.

The Official Action requires restriction between two (2) allegedly distinct groups of claims, as follows:

Group I, claims 1 to 20, directed to a method of detecting nucleic acids by SERS; and

Group II, claims 21 to 25 and 27 to 36, directed to a kit containing detection agent.

Applicants respectfully submit that the above restriction requirement is improper for failure to comply with the relevant provisions of the Manual of Patent Examining Procedure (M.P.E.P.) pertaining to unity of invention determinations.

The present application was filed under 35 U.S.C. §371 as a U.S. national stage application under the Patent Cooperation Treaty (PCT).

As stated in § 1893.03(d) of the M.P.E.P.:

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371)

applications...

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art...

The present invention is broadly directed to nucleic acid detection which occurs through surface enhancement of a SERRS active species (SAS) triggered by aggregation of metal surfaces, which aggregation is actually caused by nucleic acid target binding to a target binding species (TBS). All of the pending claims contain common technical features corresponding to the SAS, the non-aggregated metal surface, and the TBS. Thus, Applicants respectfully submit that all of the pending claims have unity of invention, because they share special technical features which define the invention.

In this respect, it is noteworthy that during the international stage of this application, the subject matter of

all of the claims then pending herein, i.e., claims 1-27, was treated as one inventive concept. See, e.g., the International Preliminary Examination Report (IPER) under PCT Rule 71.1, dated August 11, 2000.

Applicants respectfully submit that the cited reference (WO97/05280) does not justify restriction of the claims of this application. The reference does not disclose, or suggest the use of non-aggregated metal surfaces as part of the detection system described therein, and therefore neither anticipates nor renders obvious the present claims. Referring once more to the IPER, Applicants note that, in fact, no claims were found to lack novelty or an inventive step based on the cited reference. Nor did this reference form the basis of any lack of unity objection. *Id.*

Plainly, the restriction requirement fails to comply with the established United States Patent and Trademark Office practice of following the international rules regarding unity of invention in the prosecution of applications filed under §371. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration, and that all the pending claims be examined together in this application.

In order to be fully responsive to the above-mentioned requirement, Applicants hereby elect the subject matter of Group I, that is, claims 1 through 20, for consideration in this application.

Applicants hereby reserve the right to file one or more continuing applications, as provided in 35 U.S.C. §120, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully solicited.

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